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|---|-------------|----------------------|---------------------|------------------|
| 09/873,522  | 06/04/2001  | Richard E. Scordato  | M1005/7006 RJK      | 3542             |
| 26453   | 7590        | 08/08/2006           | EXAMINER            |                  |
| BAKER & MCKENZIE LLP<br>1114 AVENUE OF THE AMERICAS<br>NEW YORK, NY 10036 |             |                      | GORDON, BRIAN R     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1743                |                  |
| DATE MAILED: 08/08/2006   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/873,522

**Applicant(s)**

SCORDATO ET AL.

**Examiner**

Brian R. Gordon

**Art Unit**

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5-18-06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed May 18, 2006 have been fully considered but they are not persuasive. In view of the amendment, the 112, second paragraph, ejection of claim 17 has been withdrawn. As to claim 22 (and any other structural claim), which is directed to how one intends for the device to be held, the examiner asserts an operator can choose how the device is arranged in one's hands and furthermore control the pressure which one holds the device with. In other words, the shape of the device is not the only factor in determining how one chooses to hold the device nor determining the pressure applied thereto. Claims directed to how one holds the device and the pressure applied thereto is directed to intended use of the device. As previously stated the finger which one intends for the device to be operated with, the angle which applicant intends for an operators, hands, wrist, or arm to be arranged during use, and the pressure applicant intends to be exerted on the device is directed to intended use or a process of how one intends to use the device. Limitations directed intended use or a process of using the device are not considered to limit the structure of the device.

Applicant has amended the claims to recite a piston member operable for preventing the liquid from entering the nozzle portion. The amendment is unclear for if the device is operated so that liquid does not enter nozzle, then it is unclear how liquid is aspirated and dispensed. There is no addition structure claimed as to determine if liquid ever enters the device at all. If no liquid enters the device aspiration or dispensing cannot occur as asserted by the claim.

It should also be noted the "for" clause directed to the piston is directed to intended use of the piston. However the examiner asserts, that one can choose to use any pipette (including those cited in the prior art of record) to aspirate and dispense air. As such the plunger or piston in such a device would inherently prevent liquid from entering the device. Furthermore one can use any pipette (including those cited in the prior art of record) to aspirate a liquid only into a tip portion of a device by controlling the length with one draws in or actuates the plunger or piston to create a negative pressure. If one chooses to retract the plunger of Clifford a relative small distance, liquid will only enter the tube 23 at the immediate portion which terminates in the liquid. One does not have to retract the plunger far enough to withdraw fluid or liquid into any other portions of the device. It should be further noted that when the device of Clifford is operated to aspirate or dispense liquid, such liquid only passes through or contacts capillary 23, the liquid never enters or contacts elements 64, 62, 65, or 67 all of which may considered as a nozzle of the device. As such, Clifford is considered to meet the limitations of claim as broadly interpreted.

A to the Math, applicant asserts element 37 is not a "hook" it should be noted that applicant or any other inventor may choose to name or all any element by any name which he or she choose, doing such does not change the physical structure of the device. In view of such the examiner asserts Math could have referenced element 37 as a flexible or elastic hook and the structure would have remained the same. In considering such the examiner asserts the spring element 37 of Math is structurally equivalent to applicant's "hook" as claimed and illustrated. As seen in the figures and

disclosed in the patent the spring element is mounted via collar 40 which is seen to be adjustable and removable via screws see figure 1.

Applicant asserts that the examiner has not addressed a number of elements. While the examiner disagrees, and believes the elements have been clearly addressed. The examiner asserts the nozzle assembly of Clifford has been clearly pointed out and any element as specified above may be considered equivalent to applicant's nozzle. The cited devices can be held at any angle and operated by any angle as one desires. The cited references discloses elements which can sit stable on a surface see respective figures and while sitting thereon it can be clearly seen the nozzles do not touch the respective surfaces. As seen in the references the nozzles/tips are seen to be removable attached to respective bodies and one can operate the respective buttons or actuators with one's fingers or hands as one desires.

### ***Claim Interpretations***

As to those claims that are directed to the manner in which the device is used (such as claim 4) the examiner asserts one may use the devices of the instant invention as well as the prior art as one so desires.

As to the phrase "ergonomically shaped", this term does not imply nor specify any particular or defined shape. Applicant has not defined the term as consisting of any particular shape. What may considered ergonomic for one person may not be ergonomic for the next. Therefore, such a recitation and others which are directed to use of the term do not further structurally limit the device.

Those claims which are directed to how the device is held and positioned in an operator's hand is intended use and does not further limit the structure. One can choose to hold any device including the one of the instant applicant in manner which one desires.

As to claims 25 and 32-37, the preamble should be amended to recite operable for aspirating and dispensing fluid through a nozzle. In a dispenser such as that Ho et al. the liquid is aspirated from the container up through the tube 51 to be dispensed. As such to distinguish the aspiration, the claims should be further amended as such.

Claim 31 (and other claims directed to the same principle, for example claim 41) recites narrative language that moreso expresses a process limitation of how a tip is mounted. The tip is not positively claimed as an element. Furthermore, how one intends for a tip to mounted and used with the device is not considered further limiting of the structure.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-8, 12-80 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The tip and its relationship to the nozzle is considered critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). While the specification is enable for one operating a plunger

of a device to aspirate dispense liquid into and from a tip included thereon and preventing it from entering a nozzle. The specification is not enabled for performing as such without a tip being present if the tip is not present then where is the liquid aspirated to or dispensed from? It is unclear how the device can operate as claimed without the tip being claimed.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4-5, 12-13, 15-24, 30-31, 36, 38-41, 45-46, 47-52, 54-58, 60-61, 65-66, 68-72, and 74-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Clifford US 3,246,559.

Clifford discloses a pipetting device with an angled nozzle 64. The device is capable of aspirating and dispensing fluid into and from a cuvette 25 (as described in column 4, lines 31-49).

As seen in the figures, there is button centrally located on the head.

The holder 11 and head member 12 (including the button) are removable from one another.

The head member may be considered an adapter for when attached it changes the size of the device.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



8. Claims 3, 6-8, 25-29, 32-35, 42-44, and 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford as applied to claims 1-2, 4-5, 12-13, 15-24, 30-31, 36, 38-41, 45-46, 47-52, 54-58, 60-61, 65-66, 68-72, and 74-77 above, and further in view of Math US 2,796,204.

Math discloses the combination of a dispensing device 10 attached to a bottle 12 (bottle or bottom portion removable). As seen in the figures the device is capable of being held in one's hand and operated (via button or tab 36 substantially near the central axis) to dispense or aspirate a liquid via spout 28.

The examiner asserts that the handle element 37 may be considered a hook or the spring element 42 (as seen in the figure). The degree of the bend in the spring/hook 42 depends upon how far the tab/button 36 is depressed. The spring/hook is removable/replaceable via a screw (not labeled) and or collar 40.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Clifford to include a hook element such as that of Math in order to provide a means for holding and carrying the device.

9. Claims 14, 47, 67, and 81-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford as applied to claims 1-2, 4-5, 12-13, 15-24, 30-31, 36, 38-41, 45-46, 47-52, 54-58, 60-61, 65-66, 68-72, and 74-80 above, and further in view of Kelly et al. US 6,737,023.

Clifford does not disclose the device as comprising a mechanism for ejecting tip.

Kelly et al. discloses air displacement pipettes including a novel mounting shaft and a unique pipette tip tailored to the mounting shaft such that the tip is easily

insertable by a pipette user onto the shaft to a fluid tight position in which the tip is secured against undesired lateral rocking on or displacement from the shaft and, after use, is easily ejectable from the shaft by the pipette user; such tip insertion and ejection requiring the pipette user to only exert axial tip insertion and ejection forces of about one pound or less thereby substantially eliminating all risk of repetitive motion injury to the pipette user.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Clifford to incorporate the tip ejection mechanism as taught by Kelly et al. in order to remove and replace the tip 19 with minimal risk of injury to the user.

10. Claims 20, 37, 53, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford as applied to claims 1, 30, and 31 above, and further in view of Strandberg et al. US 5983733.

Clifford does not disclose the inventions as comprising a padding material.

Strandberg et al. discloses a hand-held pipette comprising, in combination: a hand receiving portion having an ergonomic contour, a combination fluid inlet and outlet located adjacent the hand portion, means for introducing and dispensing fluid into and out of the pipette via the inlet and outlet, and a resilient cushion disposed along an outer periphery of the hand receiving portion to reduce fatigue and trauma to a technician operating the pipette.

It would have been obvious to one of ordinary skill at the time of the invention to modify either of the devices of Clifford to incorporate the cushion or padding as taught

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by Strandberg in order to relieve or reduce fatigue to an operators hand when holding the devices.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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